REMARKS

Claim Status

Claims 1-8 remain in the application.

Claims 9-26 have been withdrawn.

Claim Rejection- 35 USC §102

The Examiner has rejected claims 1-8 under 35 USC 103(a) as being unpatentable over WO01/50121. Applicants believe that the Examiner meant to reject the claims under 35 USC 102 (e) in this instance and so will proceed. Applicants traverse this basis of rejection.

Applicants submit that WO 01/50121 fails to suggest the subject matter of any of claims 1 to 8 for the following reasons:

The cited reference WO 01/50121 discloses the picking of protein spots from a gel using a sample retrieval apparatus. A detailed description of this apparatus and the whole procedure is described on page 8, line 30 ff of WO 01/50121.

The passages of WO 01/50121 cited by the examiner on page 3 of the final Office Action describe the isolation of a protein spot from a gel but not the positioning of a gel cutting in a gel holder as claimed in claim 1 of the instant invention. According to the instant application a gel cutting from a gel layer is a gel slice which contains many single protein spots.

According to the Examiner statements on pages 3 and 4 of the Office Action, the Examiner has the impression that one of the processing wells of receiving container 32 described by WO 01/50121 (see page 5, line 7 ff) corresponds to the gel holder of the instant invention. This view is erroneous, because such a processing well does not receive an entire gel slice, but a very small portion thereof picked with the gel spot

picker described by WO 01/50121. Functionally, the gel holder of the instant invention rather corresponds to the container 34 described by WO 01/50121 (see page 5, lines 2 ff).

All the passages of WO 01/50121 cited by the examiner refer to the isolation of a protein spot from a gel e.g. a SDS gel, but not to the immobilization of the gel in a gel holder prior to the isolation of the protein spots. Paragraph [0003], page 2 of the instant application describes the whole process of isolating gel pieces from a gel layer such as that found in the primary reference.
Due consideration of this paragraph makes clear that the term "cutting of a gel layer" according to the instant application does not correspond to the gel samples isolated using the method described by WO 01/50121. Page 8, line 30 ff of WO 01/50121 contains a detailed description of the latter method for isolating of a protein spot.

Claim Rejection- 35 USC § 103

The Examiner has rejected Claims 1-3, 5-6 and 8 under 35 USC 102 (e) as being anticipated by WO 01/50121 in view of Moi et al. (USPN 5,938,906). In view of the combination of references Applicants will treat this rejection as if it was a 35 USC 103 (a) rejection. Applicants traverse this basis of rejection.
In addition to the comments with regard to US 5,938,906 (Moi et al.) in the previous Amendment filed on 8 March 2007, Applicants would point out that Moi et al. describes a cassette for casting a gel slab and that for this purpose a gelling solution is poured into the interior of the cassette, and that for this reason US 5,938,906 (Moi et al.) fails to describe a method in which a gel slab is inserted into a chamber of a gel holder as is the case in the method defined by claim 1.

On page 3 of the Final Office Action the Examiner points out that step c) of present claim 1

"c) covering the gel cutting (27) with an equilibrating liquid (31)

was known from the disclosure of WO 01/50121 (page 10, lines 11-20) which reads as follows:

"The control device 58 then directs the movement of the support platform 24 to third X and Y coordinates to position the cutter member 38 above the first available well in the multi-well processing plate 32 or other receiving container for transfer of the selected sample. The wells in the multi-well processing plate 32 are preferably **pre-filled with solution required for processing of the sample**. The cutter member 38 is then lowered along the Z axis to position the cutting tip 36 over the surface of the **processing solution** and the spring-loaded coupling shaft 74 extends the plunger 70 along the Z' axis within the passage of the cutting tip 36 to eject the selected sample in the gel fragment into the **processing solution**. Following ejection of the sample, the cutter member 38 is raised."

It is not clear that the "**processing solution**" referred to in the WO 01/50121 reference is equivalent to the equilibrating liquid of the present application. In the present invention the equilibrating liquid performs a functional task of surrounding the gel cutting to ensure a constant degree of swelling to provide a gel having the same dimensions whereas in the reference no such criticality is required or even discussed, i.e. there is no disclosure of whether the processing solution surrounds the sample gel fragment, the Examiner only conjectures such. Furthermore it is necessary that the gel cutting to lie in the equilibrating liquid for a sufficient length of time so that an equilibrium degree of swelling can be achieved at a constant temperature.

In view of the above amendments and remarks, it is submitted that claims 1-8 are patentable in view of the cited art. Early reconsideration and allowance of the claims is respectfully requested.

No further fee is required in connection the filing of this Amendment over and above those fees for an Extension of Time and a Request for Continued Prosecution. If any

additional fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,

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